

REMARKS

In Section 1, the Examiner states that the arguments filed on October 26, 2005 have been considered but are moot in view of new grounds of rejection.

In Section 5, claims 1 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6006091 to Lupien in view of U.S. Patent No. 6597921 B2 to Thandu. The applicant believes that the Examiner's arguments are not accurate and need further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claim 1 of the present invention, it is not shown that the references quoted above contain all the claim limitations as required by the

third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

First, Lupien does not describe the 3d step recited in claim 1 of the present invention: "performing (44) the setup procedures at the terminal (12) using instructions contained in a command/information signal (20) while waiting for the new bit map related information from the network (11) for completing said procedures", as alleged by the Examiner. As a proof, the Examiner quotes col. 5 lines 55-67, and col. 6 line 1-11 of Lupien. However, none of these quotes describe the limitation of 3d step of claim 1 recited above.

Specifically Lupien talks repeatedly about sending requests about terminal capabilities and updated capabilities but does not describe (expressly or inherently) the network sending a command/information signal **20** for performing setup procedures of the terminal **12** as recited in claim 1 of the present invention. For example, Lupien in col. 6 line 1-3 talks about resource allocation at call setup, wherein the mobile terminal's operating capabilities retrieved from the terminal are used as parameters input to resource allocation (which is apparently performed by the network as obvious to a person skilled in the art), but no command/information signal sent to the terminal by the network is mentioned.

Moreover, Lupien does not describe or even hint about, e.g., "waiting for the new bit map (supporting error correcting functionalities of the terminal (12)

related information from the network (11) for completing said procedures" contained in step 3 of claim 1. This is because Lupien does not disclose step 2 of claim 1 comprising of "determining (31) by the network (11) whether new bit map related information is required for completing the setup procedures by the terminal (12)" which is admitted by the Examiner on page 4, 1st paragraph of the office action of January 4, 2006. Therefore, Lupien does not disclose limitation "while waiting for the bit map" of the 3d paragraph of claim 1.

Second, Lupien does not describe the 4th step recited in claim 1 of the present invention: "completing (56, 58, 62, 64) the setup procedures by the terminal (12) using further instructions contained in the command/information signal (20) sent by the network (11), wherein said instructions are configured by the network (11) based on a new bit map signal (24b) generated by the network (11)". As a proof, the Examiner quotes col. 6 lines 18-57. However, the Applicant did not find limitation of claim 1 recited above disclosed by Lupien in col. 6 lines 18-57, as alleged by the Examiner.

Similar arguments, as to the 3rd step of claim 1, can be applied to the 4th step as well. Similarly to the above arguments, there is no disclosure by Lupien of the command/information signal or the bit map signal, recited in the 4th step of claim 1.

The Examiner further contradicts himself because on page 5 (first new paragraph) of the Office Action of August 15, 2005 the Examiner stated that Lupien fails to disclose both steps 3 and 4 of the claim 1 of the present

invention but in the Office Action of January 4, 2006 the Examiner stated the opposite.

Furthermore, the Examiner admitted that Lupien does not disclose the 2nd step of claim 1 of the present invention: "determining (31) by the network (11) whether new bit map related information is required for completing the setup procedures by the terminal (12);".

The Examiner alleges that Thandu disclose this step referring to col. 2 lines 50-63, col. 3 lines 2-20, col. 4 lines 49-59, and col. 8 lines 27-38 of Thandu. However, the Applicant is of the opinion that none of these quotes describe the limitation of the 2nd step of claim 1 quoted above.

Thandu talks about bit streams and a bit map (e.g., see col. 4 lines 49-59), but the Applicant did not find any indication expressed by Thandu regarding determining by the network whether new bit map related information is required..., as recited in the 2nd step of claim 1 of the present invention.

Even if, for the sake of argument only, we assume that the Examiner is correct alleging that the two references he recites describe all of the limitations of claim 1 of the present invention (which is not true), it can be argued that the Examiner does not show that the references he quoted contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight as required by the first criterion of MPEP paragraph 2143, quoted above. The

Federal Circuit Court has several times expressly addressed the issue.

For example, *in re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

Indeed, none of the cited references suggests, discusses or even hints about the fundamental problem which is solved by the present invention: controlling terminal fault corrections in cellular system. Lupien discloses a method for informing a network of a plurality of operating capabilities of a terminal and Thandu discloses a protocol feature. None of them talk, discuss or even hint about controlling terminal fault corrections in cellular system. Thus their combination may teach away from the present invention. But if that is not the case,

why then a person skilled in the art at the time of invention would be motivated to combine these references to come out with the present invention (see claim 1)? The Examiner does not provide the answer.

Moreover, Lupien and Krishnarajah et al. do not provide teaching or suggestion for the reasonable expectation of success of combining teachings of Lupien and Thandu, as required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

The above arguments obviate the Examiner's 103(a) rejection of claim 1.

Claim 18 is an independent system claim, which is similar in scope to claim 1 of the present invention. Therefore, arguments made above regarding novelty and non-obviousness of independent claim 1 are fully applied to claim 18 of the present invention. Therefore, claim 18 is not obvious over Lupien in view of U.S. Patent No. 6597921 B2 to Thandu under 35 USC Section 103(a) as well.

In Section 6, claims 3-9 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view Thandu, and further in view of U.S. Publication No. 2003/0100291 A1 Krishnarajah.

Claims 3-9 and 19 are dependent (directly or indirectly) claims of independent claims 1 and 18, respectively. Since independent claims 1 and 18 are not unpatentable over Lupien, in view Thandu, and further in view of Krishnarajah under 35 USC Section 103(a), as shown above, dependent claims 3-9 and 19 referred to corresponding novel independent claims 1 and 18 are also

novel, and, therefore, they are not obvious under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view of Thandu, and further in view of Krishnarajah as well.

Moreover, the Examiner did not present a precise proof of Krishnarajah teaching further unique limitations (e.g., especially in regard to claims 4, 9 and 19) recited in dependent claims 3-9 and 19 of the present invention which may still further reinforce their novelty. Additional considerations can be presented by the Applicant regarding these unique limitations of claims 3-9 and 19, if needed.

Even more importantly, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

In Section 7, claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Thandu, as applied to Claim 1 above, and further in view of U.S. Patent No. 6,782,274 B1 to Jae-Hong Park (Park et al.).

Claim 2 is a dependent claim of independent claim 1. Independent claim 1 is not unpatentable over Lupien in view of Thandu as applied to claim 1, as shown above. Since the dependent claim 2 narrows the scope of the novel and non-obvious independent claim 1, non-obviousness of claim 1 will compel non-obviousness of claim 2.

Furthermore, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

In Section 8, claims 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Thandu, and further in view of Krishnarajah as applied to claim 7 above, and further in view of U.S. Pub. No. 20040203714 A1 to Gert-Jan Van Lieshout (Van Lieshout) et al.

Claims 10-12 are indirectly dependent claims of independent claim 1. Since independent claim 1 is not unpatentable over Lupien, in view Thandu, and further in view of Krishnarajah as applied to claim 7, and further in view of Van Lieshout et al. under 35 USC Section 103(a),

as shown above, dependent claims 10-12 referred to the novel independent claims 1 are also novel, and, therefore, they are not obvious under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view Thandu, and further in view of Krishnarajah as applied to claim 7, and further in view of Van Lieshout et al. as well.

Moreover, the Examiner did not present a precise proof of Van Lieshout teaching further unique limitations recited in dependent claims 10-12 of the present invention which may still further reinforce their novelty. Additional considerations can be presented by the Applicant regarding these unique limitations of claims 10-12, if needed.

Even more importantly, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

In Section 9 claims 13 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view of Thandu, and further in view of Krisharajah, and further

in view of Van Lieshout, as applied to claim 12 above, and further in view of Park et al.

Claims 13 and 14 are dependent claims of independent claim 1. Since independent claim 1 are not unpatentable over Lupien, in view of Thandu, and further in view of Krishnarajah, and further in view of Van Lieshout et al., and further in view of Park et al. as applied to claim 12 under 35 USC Section 103(a), as shown above, dependent claims 13 and 14 referred to the novel independent claim 1 are also novel, and, therefore, they are not obvious under 35 U.S.C. 103(a) as being unpatentable over Lupien, in view Thandu, and further in view of Krishnarajah, and further in view of Van Lieshout et al. as applied to claim 12, and further in view of Park et al. as well.

Furthermore, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

In Section 10, claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Thandu, and further in view of Krishnarajah, and further

in view of Van Lieshout, and further in view of Park et al., as applied to claim 14 above, and further in view of U.S. Patent No. 6859441 B2 to Stephen G. Dick (Dick et al.).

Claim 15 is a dependent claim of independent claim 1. Independent claim 1 is not unpatentable over Lupien in view of Thandu, and further in view of Krishnarajah, and further in view of Van Lieshout, and further in view of Park et al., as applied to claim 14 above, and further in view of Dick et al., as shown above. Since the dependent claim 15 narrows the scope of the novel and non-obvious independent claim 1, non-obviousness of claim 1 will compel non-obviousness of claim 15.

Moreover, the Examiner did not present a precise proof of the above references teaching further unique limitations recited in dependent claim 15 of the present invention which may still further reinforce their novelty. Additional considerations can be presented by the Applicant regarding these unique limitations of claim 15, if needed.

Even more importantly, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable

expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

In Section 11, claims 16 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Thandu, and further in view of Krishnarajah as applied to claim 7 above, and further in view of Dick et al.

Claims 16 and 17 are dependent claims of independent claim 1. Since independent claim 1 is not unpatentable over Lupien in view of Thandu, and further in view of Krishnarajah as applied to claim 7 above, and further in view of Dick et al. under 35 USC Section 103(a), as shown above, dependent claims 16 and 17 referred to the novel independent claims 1 are also novel, and, therefore, they are not obvious under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Thandu, and further in view of Krishnarajah as applied to claim 7 above and further in view of Dick, et al. as well.

Moreover, the Examiner did not present a precise proof of the above references teaching further unique limitations recited in dependent claims 16 and 17 of the present invention which may still further reinforce their novelty. Additional considerations can be presented by the Applicant regarding these unique limitations of claims 16 and 17, if needed.

Even more importantly, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or

to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

In Section 12, claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Thandu, and further in view of Park et al.

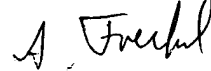
Claim 20 is a dependent claim of independent claim 18. Independent claim 18 is not unpatentable over Lupien in view of Thandu, and further in view of Park et al., as shown above. Since the dependent claim 20 narrows the scope of the novel and non-obvious independent claim 18, non-obviousness of claim 18 will compel non-obviousness of claim 20.

Furthermore, it was not shown in the Office Action of January 4 2006 that the quoted references contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings without the benefit of hindsight, as required by the first criterion of MPEP paragraph 2143 and the case law, to establish a *prima facie* case of obviousness. Also, the above references do not provide teaching or suggestion for the reasonable expectation of success of combining their teachings as also required by the MPEP paragraph 2143.

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The rejections and objections of the Official Action of January 4, 2006 having been obviated by Amendment or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is earnestly solicited.

Respectfully submitted,



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